

## REMARKS

### Summary of the Claim Amendments

1. Claims 21 in line 5 has had the superfluous "a" deleted.
2. Claims 1, 11 and 21 have had the expression "may be inserted" replaced by "are insertable,"
3. Claim 1 line 12, claim 11 - line 13 and claim 21 - line 13 have been clarified to avoid any indefiniteness by adding the word "inserted" in front of "markings."

### Response to Application's Claim Objections and Rejections

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

#### I. Objection to Claim 21

Claim 21 has been amended to delete the superfluous "a" that appeared in its line 5.

#### II. Rejection of Claims 1-30 Under §112 As Being Indefinite, With The Examiner Noting That for Claims 1, 11 and 21, "the phrase "may be" renders the claim indefinite ...."

Claims 1-30 have been amended so as to resolve their indefiniteness by replacing the expression "may be inserted" with "are insertable,"

The Applicant respectfully argues that the Examiner commits clear error in his further "indefiniteness" rejections based on the lack of an antecedent basis because:

In claim 1 – line 5, claim 11 - line 5 and claim 21 - line 5, the antecedent basis for “said software” is found in the second line of these claims where one sees “a word processing software.”

In claim 1 – line 4, claim 11 - line 5 and claim 21 - line 5, the antecedent basis for “said writing” is found in the first or second lines of these claims where one sees “an electronic writing.”

In claim 1 – line 12, claim 11 - line 13 and claim 21 - line 13, the antecedent basis for the amended expression “said inserted markings” is found in the sixth to eight lines of these claims where one sees “a marking to be inserted into said writing.”

In claim 11 – line 8 and claim 21 - line 8 the antecedent basis for “said set of markings” is found in the seventh line of these claims where one sees “a set of editorial markings.”

In claim 21 – lines 12-13, the antecedent basis for the amended expression “said system” is found in the first line of this claim where one sees “a system including ....”

Consequently, dependent claims 2-10, 12-20 and 22-30 are seen to not be indefinite for any “lack of antecedent basis” errors in their base claims, since, as explained above, no such errors now occur in their amended base claims.

### **III. Rejection of Claims 1-6, 8, 10-16, 18, 20-26, 28 and 30 Under §103(a) As Being Obvious In View Of Patent Application Publication 2002/0042800A1 to Hwang**

The Applicant respectfully argues that the Examiner commits clear error in this rejection because:

(1) With respect to Claim 1, this claim is not obvious in view of Hwang because:  
the Examiner clearly mischaracterizes portions of the Hwang invention which leads him to incorrectly assert that portions of Hwang are comparable to analogous parts of the claimed invention. For example:

(i) The claimed “method for providing feedback on an electronic writing created with a word processing software and wherein said writing being displayable using said software on a video display of a computer system” is not, as the Examiner asserts, disclosed in Hwang's page 5, paragraph 0105.

What is disclosed at Hwang's page 5, paragraph 0105 is "the technique of this invention can also apply to normal office software ...."

But what is the technique of Hwang's invention? Unfortunately, and probably because of the awkwardness of the translation of Hwang's application from Chinese to English, it is not exactly clear what is the technique of Hwang's invention.

It is titled "Method For Note Recording The Contents of The Web Page On Line," which is certainly not standard English. Does this title mean to convey "Method For Recording Notes Within The Contents of Information Found On A Web Page"? The Applicant asserts that it does.

Support for this assertion is found on page 1, paragraph 0004 where the example is given of how a teacher could use the present invention to put notes in teaching materials being presented on the Internet so that their students do not have to take notes.

A closer reading of Hwang's page 5, paragraph 0105 reveals "the note recording for Office software is as stated before that its processes is too complicated, so if the techniques of this invention can be used, then the goal for note recording can be achieved with fewer steps."

This is again an example of the awkward English wording in Hwang. However, one interpretation of this sentence seems to indicate that Hwang admits that "Office software" has the ability for one to add notes to text created with such Office software, but that a goal of his invention is to make this process easier by utilizing fewer steps.

Thus, we again arrive at the conclusion that what Hwang's invention does is enable one to, in a process with fewer steps, place notes in various types of information, either that found on a web page or that created by normal Office Software (e.g., WORD, EXCEL, OUTLOOK, POWERPOINT).

From this conclusion, it is also clear that the Examiner is incorrect when he characterizes Hwang's invention as a "method for providing feedback on an electronic writing created with a word processing software and wherein said writing being displayable using said software on a video display of a computer system."

(ii) The words "feedback on an electronic writing" are nowhere to be found in Hwang. Thus, Hwang cannot be assumed to be addressing this specific task of the present application

(iii) Hwang does not anywhere in his disclosure specifically address "electronic writings that are displayable on a video display." Thus, the Examiner is unjustified in asserting that Hwang's page 5, para. 0105 makes such a disclosure which is a necessary part of the present application.

(iv) The words and phrases "editorial marking" and "developing a set of editorial markings that are insertable into said electronic writing" are nowhere to be found in Hwang. Hwang speaks of "recording notes" in information, not of "inserting editorial marks in electronic writings." Thus, these key elements of the present claimed invention are not disclosed in Hwang.

(v) The claimed step of "selecting from said set of editorial markings a marking to be inserted into said writing" is not, as the Examiner asserts, disclosed in Hwang's page 2, paragraph 0040 and 0077. What is disclosed in these paragraphs is "choosing contents of the web page ..." and "note recording the contents .." and "saving them .. inside the server" and "inserting the selected web page contents into the note record file." Again, no disclosure is provided in Hwang of "editorial markings" or "inserting them into an electronic writing."

(vi) The claimed step of "saving information pertaining to said inserted marking in said computer system so as to establish a database that documents the use of said inserted markings in said writing" is not, as the Examiner asserts, disclosed in Hwang's page 2, paragraph 0040. What is disclosed in this paragraph is "choosing contents of the web page ..." and "note recording the contents .." and "saving them .. inside the server." Again, no disclosure is provided in Hwang of "information pertaining to said inserted editorial markings" or "saving such information" or "establishing a database that documents the use of said inserted markings in said writing."

(vii) The claimed steps of "developing a set of editorial markings that are insertable into said writing" and "inserting said editorial marking into said electronic writing" are admitted by the Examiner to not be disclosed in Hwang. However, the Examiner incorrectly asserts that the Applicant's disclosure at page 1, lines 22-44 and page 2, lines 3-4 are an admission by the Applicant that these steps are known in the art and therefore, that it would have been obvious to have included them in the invention of Hwang.

The Applicant argues that this assertion is incorrect because the Examiner has not provided the required prior art reference that teaches that the proposed modification of Hwang is

desirable. See the legal precedent in In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) and In re Fritch 922 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). These cases emphasize that *"the prior art must teach that the modification proposed is desirable, not just that it is possible."*

See also *"the test of obviousness is not whether "it was obvious to try" a particular combination of elements, for that test ignores the possibility of invention residing in the inventors' recognition of the problem."* Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1053, 5 USPQ 2d 1434 (Fed. Cir. 1988).

The Applicant also argues that the Examiner has not provided a reason that suggests the desirability of modifying Hwang in the manner cited.

"If references are said to render the claims obvious, there must be something in the references which suggest the desirability of their combination." Litton System, Inc., v. Honeywell, Inc., 87 F.3d 1559, 1569, 39 USPQ 2d 1321 (Fed. Cir. 1996) ("[T]he record discloses no teaching or suggestion to combine any of these references. The absence of a suggestion to combine is telling in an obviousness determination"); In re Paulsen, 30 F.3d 1475, 1482, 31 USPQ 2d 1617 (Fed. Cir. 1994); Heidelberger Druckmaschinen AG v. Hantscho Commercial Products Inc., 21 F.3d 1068, 1072, 30 USPQ 2d 1377 (Fed. Cir. 1994) ("When the patent invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination"); Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1568, 1 USPQ 2d 1593 (Fed. Cir.) ("elements of separate prior patents cannot be combined when there is no suggestion of such combination anywhere in those patents").

- (2) With respect to Claim 2, this claim is not obvious in view of Hwang because:  
the Examiner clearly mischaracterizes the portion of the Hwang disclosure at page 2, para. 0038, which leads him to incorrectly assert that this portion of Hwang is comparable to the claimed step of "compiling summary statistics for said saved inserted editorial markings that communicate information pertaining to the use of said markings in said writing."

Examination of page 2, para. 0038 clearly shows that this paragraph does not contain such key words and phrases from the claimed step as "editorial marking" and "compiling summary statistics" and "information pertaining to the use of said markings in said writing."

Instead, this paragraph of Hwang concerns itself with inserting letters in files that allow one to download an object associated with the letter from the Internet (i.e., the letter is apparently a type of hot-link button) – which clearly has nothing to do with the claimed step of Claim 2.

(3) With respect to Claim 3, this claim is not obvious in view of Hwang because:

the Examiner clearly mischaracterizes the portion of the Hwang disclosure at page 2, para. 0040, which leads him to incorrectly assert that this portion of Hwang is comparable to the claimed step of “filtering said inserted editorial markings so that only a specified portion of such markings remain in said writing when it is returned to its writer.”

Examination of page 2, para. 0040 clearly shows that this paragraph does not contain such key words and phrases from the claimed step as “editorial markings” and “filtering said inserted editorial markings” and “only a specified portion of such markings remain in said writing.”

Instead, this paragraph of Hwang concerns itself with using “the Single-Action to request for note recording (?)” which clearly has nothing to do with the claimed step of Claim 3.

(4) With respect to Claims 4-6, these claims are not obvious in view of Hwang because:

the Examiner clearly mischaracterizes the portion of the Hwang disclosure at page 4, para. 0094, which leads him to incorrectly assert that this portion of Hwang is comparable to the claimed step of “hyperlinking said inserted editorial marking to a website that exists on a network of linked computers.”

Examination of page 4, para. 0094 clearly shows that this paragraph does not contain such key words and phrases from the claimed step as “editorial marking” and “hyperlinking said inserted editorial marking” and “a website that exists on a network of linked computers.”

Instead, this paragraph of Hwang concerns itself with “note record the contents of the web page ... (even) other web page objects (?)” – which clearly has nothing to do with the claimed step of Claim 4. The fact that the word hyperlink is used in this paragraph does not make it pertinent to Claim 4.

(5) With respect to Claim 8, this claim is not obvious in view of Hwang because:

the Examiner clearly mischaracterizes the portion of the Hwang disclosure at page 2, para. 0040 and page 3, para 0077, which leads him to incorrectly assert that this portion of Hwang is comparable to the claimed limitation or clarification of “wherein said compiled

summary statistics communicate information selected from the group consisting of information pertaining to: (a) specified skills that said writer would need to focus upon in order to improve said writer's writing skills, (b) for a series of said writings by the same writer, said writer's progress towards improvement in those areas identified by said inserted markings as needing improvement, (c) for a collection of writings by a group of writers who are being instructed as a group, said group's general areas denoted by said inserted markings as needing improvement, and (d) for a series of writings by said group, said group's progress towards improvement in those areas identified by said inserted markings as needing improvement."

Examination of these paragraphs clearly shows that they do not contain such key words and phrases from the claimed clarification as "editorial marking," "compiled summary statistics," or any of the types of information enumerated above in (a)-(d).

Instead, as noted above, page 2, para. 0040 concerns itself with using "the Single-Action to request for note recording (?)"— which clearly has nothing to do with the claimed clarification step of Claim 8.

Meanwhile, page 3, para. 0077 concerns itself with a so-called Step S43: opening a note record file automatically (?)"— which clearly has nothing to do with the claimed clarification of Claim 8.

- (6) With respect to Claim 10, this claim is not obvious in view of Hwang because: the Examiner clearly mischaracterizes the portion of the Hwang disclosure at page 2, para. 0038 and 0040, which leads him to incorrectly assert that this portion of Hwang is comparable to the claimed limitation or clarification of "wherein said inserted editorial marking having an associated editorial comment that is insertable in said writing."

Examination of page 2, para. 0038 and 0040 clearly show that these paragraphs do not contain such key words and phrases from the claimed limitation as "editorial markings" and "associated editorial comment" and "insertable in said writing."

Instead, as noted above, page 2, para. 0040 of Hwang concerns itself with using "the Single-Action to request for note recording (?)"— which clearly has nothing to do with the claimed limitation of Claim 10.

Meanwhile, as noted above, page 2, para. 0038 of Hwang concerns itself with inserting letters in files that allow one to download an object associated with the letter from the Internet

(i.e., the letter is apparently a type of hot-link button) – which clearly has nothing to do with the claimed limitation of Claim 10.

(7) With respect to Claim 11, the Examiner correctly notes that this claim “is directed to a computer program product for implementing the method of claim 1. Thus, it follows that this claim should be allowable for the reasons given above as to why the Examiner has acted improperly in rejecting Claim 1.

(8) With respect to Claims 12-16, 18 and 20, the Examiner correctly notes that these claims state the same limitation as in Claims 2-6, 8 and 10. Thus, it follows that these claim should be allowable for the reasons given above as to why the Examiner has acted improperly in rejecting Claims 2-6, 8 and 10.

(9) With respect to Claim 21, the Examiner appears to infer that this claim “is directed to a computer system for implementing the method of claim 1. The Applicant agrees with this inference. Thus, it follows that this claim should be allowable for the reasons given above as to why the Examiner has acted improperly in rejecting Claim 1.

(10) With respect to Claims 22-26, 28 and 30, the Examiner correctly notes that these claims state the same limitation as in Claims 2-6, 8 and 10. Thus, it follows that these claim should be allowable for the reasons given above as to why the Examiner has acted improperly in rejecting Claims 2-6, 8 and 10.

#### **IV. Rejection of Claims 7, 17 and 27 Under §103(a) As Being Obvious In View Of Patent Application Publication 2002/0042800A1 And USPN 5,576,955**

The Applicant respectfully argues that the Examiner commits clear error in this rejection because:

(1) Claims 7, 17 and 27, which depend directly from Claim 1 or its equivalents 11 and 21, are nonobvious, (regardless of the limitations introduced by Claims 7, 17 and 27 or the nature of the disclosure in Newbold) because these Claims effectively depend from Claim 1 which, for the reasons given above, is nonobvious.

(2) With respect to Claim 7, this claim is not obvious in view of Hwang and Newbold because:



the Examiner clearly mischaracterizes the portion of the Hwang disclosure at page 2, para. 0038 and 0040 and page 3, para. 0077, which leads him to incorrectly assert that this portion of Hwang when combined with the other cited references is comparable to the claimed limitation or clarification of "wherein said inserted editorial marking communicates information, regarding a portion of said writing in proximity to said marking's insertion point ..."

Examination of Hwang's cited paragraphs clearly show that they do not contain such key words and phrases from the claimed limitation as "editorial marking" and "communicates information regarding a portion of said writing in proximity to said marking's insertion point."

Instead, as noted above, page 2, para. 0040 of Hwang concerns itself with using "the Single-Action to request for note recording (?)" – which clearly has nothing to do with the claimed limitation of Claim 7.

Also, as noted above, page 2, para. 0038 of Hwang concerns itself with inserting letters in files that allow one to download an object associated with the letter from the Internet (i.e., the letter is apparently a type of hot-link button) – which clearly has nothing to do with the claimed limitation of Claim 7.

Meanwhile, as noted above, page 3, para. 0077 concerns itself with a so-called Step S43: opening a note record file automatically (?)" – which clearly has nothing to do with the claimed clarification of Claim 7.

(3) With respect to Claim 17, this claim is not obvious in view of Hwang and Newbold because:

the Examiner correctly notes that this claim "has the same limitations as in Claim 7." Thus, it follows that this claim should be allowable for the reasons given above as to why the Examiner has acted improperly in rejecting Claim 7.

(4) With respect to Claim 27, this claim is not obvious in view of Hwang and Newbold because:

the Examiner correctly notes that this claim "has the same limitations as in Claim 7." Thus, it follows that this claim should be allowable for the reasons given above as to why the Examiner has acted improperly in rejecting Claim 7.

**V. Rejection of Claims 9, 19 and 29 Under §103(a) As Being Obvious In View Of Patent Application Publication 2002/0042800A1 And USPN 5,987,302**

The Applicants respectfully argue that the Examiner commits clear error in this rejection because:

(1) Claims 9, 19 and 29, which depend indirectly from Claim 1 or its equivalents 11 and 21, are nonobvious, (regardless of the limitations introduced by Claims 9, 19 and 29 or the nature of the disclosure in Driscoll) because these Claims effectively depend from Claim 1 which, for the reasons given above, is nonobvious.

(2) With respect to Claim 9, this claim is not obvious in view of Hwang and Driscoll because:

the Examiner clearly mischaracterizes the portion of the Driscoll at col. 4, lines 47-65 and col. 6, line 50 to col. 7, line 1, which leads him to incorrectly assert that this portion of Driscoll when combined with the other cited references is comparable to the claimed limitation or clarification of "wherein said website having information chosen from the group consisting of detailed explanations of said editorial markings and exercises that one can undertake in order to strengthen those writing skills which are denoted by said inserted markings as representing areas in which said writer needs improvement."

Examination of Driscoll's cited paragraphs clearly show that they do not contain such key words and phrases from the claimed limitation as "editorial marking" and "explanations of said editorial markings" and "exercises that one can undertake in order to strengthen those writing skills which are denoted by said inserted markings as representing areas in which said writer needs improvement."

Instead, col. 4, lines 47-65 of Driscoll concern themselves with a system that provides for an overall-comment and pre-defined comments on essay responses to selected essay questions. This is not analogous to a website having explanations of inserted editorial markings or exercises to strengthen those writing skills which are denoted by the inserted markings as representing areas in which the writer needs improvement.

(3) With respect to Claim 19, this claim is not obvious in view of Hwang and Driscoll because:

the Examiner correctly notes that this claim "has the same limitations as in Claim 9." Thus, it follows that this claim should be allowable for the reasons given above as to why the Examiner has acted improperly in rejecting Claim 9.

(4) With respect to Claim 29, this claim is not obvious in view of Hwang and Driscoll because:

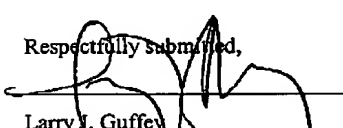
the Examiner correctly notes that this claim "has the same limitations as in Claim 9." Thus, it follows that this claim should be allowable for the reasons given above as to why the Examiner has acted improperly in rejecting Claim 9.

# REQUEST FOR RECONSIDERATION

In view of the above, it is submitted that the Applicant's amended claims are in condition for allowance. Reconsideration and allowance of amended claims 1-30 are requested.

Alternatively, with few amendments, it is submitted that these claims could easily be placed in a condition for allowance. The Applicant hereby requests that the Examiner establish informal communications with the Applicant's Attorney for the purposes of determining what form such amendments might take.

Respectfully Submitted,

  
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